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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jon Gingrich

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EXAMINER

NGUYEN, TUAN VAN

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/808,427	Applicant(s) GINGRICH ET AL.	
	Examiner TUAN V. NGUYEN	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 13, 18, 19, 21, 22, 24-27, 30, 31, 38, 39, 42, 43, 46, 52, 58 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 13, 15-17, 23, 28, 29, 33, 34, 36, 37, 40, 41, 44, 48, 49, 51, 54-57, 61, and 72-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-3,7,8,13-19,21-31,33,34,36-44,46,48,49,51,52,54-59,61 and 72-94.

DETAILED ACTION

1. This Office action is in response to the RCE filed on May 4, 2009.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 4, 2009 has been entered.

Response to Amendments

3. According to the amendments, claims 32, 35, 53 and 60 have been canceled and claims 91-94 are new. Accordingly, claims 1-3, 7, 8, 13-19, 21-31, 33, 34, 36-44, 46, 48, 49, 51, 52, 54-59, 61 and 72-94 are pending in this present application. Claims 14, 18, 19, 21, 22, 24-27, 30, 31, 38, 39, 42, 43, 46, 52, 58, 59 previously withdrawn and claims 1-3, 7, 8, 13, 15-17, 23, 28, 29, 33, 34, 36, 37, 40, 41, 44, 48, 49, 51, 54-57, 61, and 72-94 are presented for examination.

Response to Arguments

4. Applicant's arguments with respect to that Alden fails to disclose all limitation in independent claims 72 and 84 have been fully considered and persuasive, therefore, the previous rejection is hereby withdrawn. With respect to the arguments that Yanamoto in view of Alden and Dever fails to disclose all limitation in independent claims 1, 72 and 84 have been fully considered and persuasive, therefore, the previous rejection is hereby withdrawn. However, upon further consideration and search the claims, which presented for examination, are rejected in view of new ground of rejection.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 2, recites the limitation of "one half of a cross-section of the elongate member", the specification fails to provide antecedent basis for this limitation.

Claim Objections

6. Claims 7, 8, 16, 17, 48, 49 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-3, 7, 8, 13, 15-17, 23, 28, 29, 33, 34, 37, 40, 41, 44, 48, 49, 51, 54-57, and 72-94 are rejected under 35 U.S.C. 102(b) as being anticipated by DiBernardo et al. (U.S. 5,344,011).**
9. Referring to claims 1, 7, 8, 16, 17, 23, 28, 40, 41, 48, 49, 51, 54, 56, 57, 72, 76-82, 84, and 86-94, DiBernardo et al. teach (Figs. 1-3) a compact packaging system for elongated flexible product such angioplasty catheter balloon and the like (Abstract and col. 1, lines 11-25) comprising, inter alia: a handle includes an elongate portion and a spool, wherein the spool includes a proximal portion, distal portion and a central portion (see Examiner interpretation of the handle, elongate portion and the spool as shown in Fig. 1, which reproduced below); a balloon 27 or an end effector assembly 27; an elongate flexible member, includes sheath 14 and/or catheter body of catheter 20, together or individually, the elongate flexible member forming loops 19 and connecting the handle to the end effector assembly. Figures 1 and 2 of Alden's drawing show the spool further includes a plurality of grooves on the distal, proximal and central portions, wherein the plurality of grooves on the distal portion are circumferentially aligned with plurality of grooves on the central and proximal portions; at least one groove accommodates a portion of the balloon

10. Referring to claims 2, 3, 73 and 74, Figure 2 shows the at least one groove is received at least one half of a cross-section of the elongate member and the width of the at least one groove is substantially the same as the outer diameter of the elongate member and length of the grooves is greater than the aggregate diameters of the loops.
11. Referring to claims 13, 15 and 44, Figures 1 and 2 of 's drawing show the plurality of grooves on the distal portion extend through the central portion and proximal and central portions, wherein the plurality of grooves on the distal portion are circumferentially aligned with plurality of grooves on the central and proximal

portions. With respect to the limitation of one groove is configured to accommodate more than one portion of the elongate member, "more than one portion", in a broad sense, it can be interpreted as a loop can has more than one portions, wherein each portion is an arch, integrally connected to each other to form a loop. Thus, Figures 1 and 2 show one groove accommodates more than one portion of a loop.

12. Referring to claim 29, the groove 13 as shown in Figure 2 of DiBernado's drawings is capable of receiving more than one loops of the catheter body or elongate member.
13. Referring to claims 33, 34, 37 and 55, Figure 1 reproduced above paragraph 10 shows the spool further includes a throughhole extending through the proximal, distal, and central portions, show by reference number 11, which receive the elongate portion therethrough.
14. Referring to claims 75, 83, and 85, Figure 1, which reproduced above paragraph 10, discloses a notch on a portion of the proximal portion of the spool receive an elongate portion, which includes 22 and 23, of the handle.
15. Referring to claim 90, Figure 2 shows the device of DiBernado includes at least one notch 17 has a width narrower than a diameter of the sheath 14.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
18. **Claims 36, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiBernardo et al. (U.S. 5,344,011) in view of Whittier et al. (U.S. 5,702,080).**
19. DiBernardo discloses the invention substantially as claimed except for specifically disclosing the end effector assembly is a forceps. However, Whittier discloses (Fig. 5) the long narrow tube and the forceps jaws of an endoscopic forceps should be coiled into loop and the forceps jaw should also be protected for the purpose of facilitating ease of packaging, storing, and retrieving of the device. Noting that the design intended of the housing 11 of DiBernardo device is also similar with the desired of Whittier and it is capable to be modified by one of ordinary skill in the art to accommodate the device of Whittier. Therefore, it would have been obvious to one of ordinary skill in the art to try to modify the housing 11 as disclosed by DiBernardo to accommodate the endoscopic forceps device as

disclosed by Whittier to further improve the utility of the housing 11 because it has been held that substitute one known element for another to obtain predictable results is old and well known in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan V Nguyen/

Examiner, Art Unit 3731